

Application No.: 10/762,554**Docket No.: 713-1048****REMARKS**

Applicants appreciate the Examiner's thorough review of the present application, and respectfully request reconsideration in light of the preceding amendments and the following remarks.

Claims 9-28 are pending in the application. Original claims 1-8 have been cancelled without prejudice or disclaimer and replaced with new claims 9-28 which are believed to better define the claimed invention. The newly added claims find solid support in the original application, especially the drawings. No new matter has been introduced through the foregoing amendments.

The objection to and rejections of the original claims are moot in view of the above amendments.

New claims 9-28 are believed free of any indefiniteness issue within the meaning of 35 U.S.C. 112, second paragraph. New claims 9-28 are also believed patentable over the applied art of record.

In particular, new independent claim 9 is directed to a fastening apparatus, comprising: a muzzle; a piston slidable within and along an axis of the muzzle for driving fasteners out of the muzzle; and a lateral positioning member having a plurality of different, lateral bearing surfaces and being moveable relative to said muzzle so as to bring any of the different, lateral bearing surfaces to a reference position in which said lateral bearing surfaces are spaced from the axis of said muzzle by different distances, respectively, and in which said lateral bearing surfaces are placeable against a side of a workpiece, to whereby allow positioning of said muzzle at said different distances from the side of the workpiece. The primarily applied reference of *Lin* (U.S. Patent No. 5,261,588) discloses a single lateral bearing surface at 381 as best seen in FIGs. 5, 7 and 8 of the reference. The reference is not modifiable to include multiple different lateral bearing surfaces as presently claimed, lacking a proper suggestion or motivation in the art. The teaching

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reference of *Haddon* (U.S. Patent No. 4,729,698) does not cure the deficiency of *Lin*. Therefore, independent claim 9 is patentable over the applied references.

Claims 10-18 depend from claim 9, and are considered patentable at least for the reason advanced with respect to claim 9. Claims 10-18 are also patentable on their own merits since these claims recite other features of the invention neither disclosed, taught nor suggested by the applied art.

For example, as to claims 10-17, the applied references, especially *Lin*, clearly fail to teach or suggest that the lateral positioning member is **rotatably** attached to said muzzle. In *Lin*, body 32 is slidably mounted to nailing gun 10. See, for example, column 2, line 49, and FIGs. 5 and 7 of *Lin*.

As to claim 18, the applied references, especially *Lin*, clearly fail to teach or suggest the claimed **plurality of different locking elements** for releasably locking said lateral positioning member and said muzzle at any of a plurality of different relative positions, respectively, each of said relative positions corresponding to one of said different locking elements and one of lateral bearing surfaces being placed in the reference position. In *Lin*, a single locking element is provided i.e., bolt 37 in FIG. 2 of the reference.

New independent claim 19 is directed to a fastening apparatus, comprising: a muzzle; a piston slidable within and along an axis of the muzzle for driving fasteners out of an end of the muzzle; an axial positioning member for adjusting a first distance from the end of the muzzle to a first surface of a workpiece; a lateral positioning member for adjusting a second distance from the end of the muzzle to a second surface of the workpiece; and a **common, elongated fastening element** that attaches both said axial positioning member and said lateral positioning member to said muzzle. The Examiner proposed to combine *Lin* with *Haddon* to arrive at a fastening apparatus including adjustability in both axial and lateral directions. However, assuming *arguendo*

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that the Examiner's combination is proper, the combined device would still require two separate bolts each for attaching one of the adjusting elements to the muzzle, namely, bolt 37 (FIG. 2) of *Lin* and bolt 50 (FIG. 5) of *Haddon*. The references are not further modifiable to include a common elongated fastening element that attaches both said axial positioning member and said lateral positioning member to said muzzle as presently claimed. Therefor, independent claim 19 is patentable over the applied references.

Claims 20-23 depend from claim 19, and are considered patentable at least for the reason advanced with respect to claim 19. Claims 20-23 are also patentable on their own merits since these claims recite other features of the invention neither disclosed, taught nor suggested by the applied art.

For example, as to claims 20-21, the applied references clearly fail to teach or suggest that the said lateral positioning member is **moveably attached** by said elongated fastening element to said muzzle, whereas said axial positioning member is **immoveably fixed** by said elongated fastening element to said muzzle. The bolts of the references, if properly modified to be used commonly for attaching both the adjusting elements to the muzzle, would either immoveably fasten or release both adjusting elements.

As to claim 22, the applied references clearly fail to teach or suggest that said lateral positioning member is **rotatably** attached by said elongated fastening element to said muzzle, as argued with respect to claim 10.

As to claim 23, the applied references clearly fail to teach or suggest that said lateral positioning member has a **plurality of different, lateral bearing surfaces** which are placeable, by a rotation of said lateral positioning member, in a reference position in which said different, lateral bearing surfaces are spaced from the axis of said muzzle by different distances, respectively, as argued with respect to claim 9.

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New independent claim 24 is directed to a fastening apparatus, comprising: a muzzle; a piston slidable within and along an axis of the muzzle for driving fasteners forwardly from an end of the muzzle; an axial positioning member having an axial bearing surface positioned forward of the end of the muzzle, said axial positioning member being fixable to said muzzle at various locations for adjusting a first axial distance between said axial bearing surface and the end of said muzzle; and a lateral positioning member having a **plurality of different, lateral bearing surfaces** and being rotatably attached to said muzzle, wherein said different, lateral bearing surfaces are placeable, by a rotation of said lateral positioning member, in a reference position in which said different, lateral bearing surfaces are forward of the end of said muzzle and spaced from an axis of said muzzle by different distances, respectively. The applied references clearly fail to teach or suggest, at least, the highlighted limitations, as argued with respect to claim 9.

Claims 25-28 depend from claim 24, and are considered patentable at least for the reason advanced with respect to claim 24. Claims 25-28 are also patentable on their own merits since these claims recite other features of the invention neither disclosed, taught nor suggested by the applied art.

For example, as to claim 25, the applied references clearly fail to teach or suggest a bolt having a head at an end thereof and extending through a first hole in said lateral positioning member to define a rotational axis of said lateral positioning member; a nut threaded onto an opposite end of said bolt; and a **spring** disposed together with said lateral positioning member between said nut and the head of said bolt; wherein said lateral positioning member is rotatably attached to said muzzle by said bolt, nut and spring while remaining moveable along the bolt upon elastic deformation of said spring.

As to claim 26, the applied references clearly fail to teach or suggest a bolt that extends through **both** the axial positioning member and the lateral positioning member. Note also the argument advanced with respect to claim 19.

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As to claim 27, the applied references clearly fail to teach or suggest a **plurality of different locking elements** arranged circumferentially about the first hole, each of said locking elements corresponding to one of said lateral bearing surfaces; wherein said second section of said axial positioning member comprises a matching locking member engageable with any of said locking element of the lateral positioning member to whereby releasably lock any of the lateral bearing surfaces in the reference position when the corresponding locking element is engaged with said locking member, as argued with respect to claim 18.

As to claim 28, the applied references clearly fail to teach or suggest a **spacer** having a first end abutting said second section of said axial positioning member and a second end abutting said nut, so as to rigidly press the grooved surfaces against each other when said nut is fastened and allow disengagement of said grooved surfaces and axial movement of the axial positioning member along said muzzle when said nut is loosened.

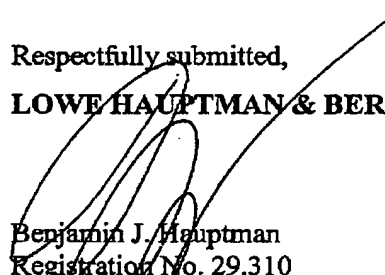
Each of the Examiner's rejections has been traversed/overcome. Accordingly, Applicants respectfully submit that all claims are now in condition for allowance. Early and favorable indication of allowance is courteously solicited.

The Examiner is invited to telephone the undersigned, Applicant's attorney of record, to facilitate advancement of the present application.

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To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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703-872-9306
FACSIMILE NUMBER